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08/471,890	06/07/1995	DONALD R. HUFFMAN	MITS-003/05US 308622-2007	9010
58249	7590	10/04/2010	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			YUAN, DAH WEI D	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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Mailed:

In re application of

Huffman et al.

Serial No. 08/471,890

Filed: June 7, 1995

For: New Form Of Carbon

OCT 04 2010

DECISION ON  
PETITION

This is a response to the petition under 37 CFR 1.181 filed August 23, 2010. Applicant requests entry of the supplemental amendment filed September 25, 2009 or alternatively that the finality of the Office action dated June 23, 2010 be withdrawn.

A review of the record indicates that applicant's amendment of March 12, 2009 cancelled claims 89-121 and presented new claims 122-163. The supplemental amendment of September 25, 2009 presented new claims 164-245. The examiner in the final rejection of June 23, 2010 denied entry of the supplemental amendment. Applicant asserts that claims 202-245 of the supplemental amendment incorporate amendments that were suggested by the Office and address concerns raised by the examiner and in any case clearly simplify the issues for appeal under section (F) of 37 CFR 1.111.

Supplemental replies are governed by 37 CFR 1.111(a) (2).

37 CFR 1.111(a) (2) states:

*(2) Supplemental replies.*

(i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a) (2) (ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

- (A) Cancellation of a claim(s);
- (B) Adoption of the examiner suggestion(s);
- (C) Placement of the application in condition for allowance;
- (D) Reply to an Office requirement made after the first reply was filed;
- (E) Correction of informalities (*e.g.*, typographical errors); or
- (F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

At the September 23, 2008 interview it was agreed that an amendment would be made canceling the pending claims and adding a new set of claims mirroring those allowed in corresponding parent application 07/580,246, now U.S. Patent 7,494,638, but limited to “cage molecules consisting of carbon atoms soluble in non-polar organic solvents”.

On March 12, 2009, applicant filed an amendment, cancelling claims 89-121 and adding new claims 122-163 that did not include the agreed upon language in all of the independent claims. The claims were not limited to “cage molecules consisting of carbon atoms soluble in non-polar organic solvents”. Instead, the claims were directed to “cage molecules consisting of carbon atoms”. The examiner in an interview on September 11, 2009 proposed an examiner’s amendment which incorporated language that was initially agreed upon in the interview dated September 23, 2008; “cage molecules consisting of carbon atoms soluble in non-polar organic solvents”. Agreement was not reached. Two additional interviews were conducted with the examiner of record on September 23 and 24, 2009.

Applicant’s representative proposed a draft amendment on September 23, 2009 which had adopted the examiner’s proposed amendment for claims 122-163 and added new claims 164-181. Upon review of proposed new independent claim 164, the examiner did not accept the proposed draft amendment. Specifically, the examiner had concerns with the language that “A substantially pure fullerene compound comprising a polyhedral carbon cage” was not supported by the original disclosure because the meaning of fullerene encompasses carbon nanotubes and that the term fullerene was not used in the original disclosure. The examiner did not accept applicant’s proposed amendment.

Applicant then filed a supplemental amendment on September 25, 2009 where claims 164-245 were newly presented. Applicant asserts that claims 164-201 are duplicates of the claims suggested by the examiner and are therefore allowable. Applicant further states that claims 202-245 are newly presented and responsive to the interviews with the examiner. Applicant cites newly proposed claims 203, 204, 216, 217, 224, 225, 236 and 237 as incorporating suggestions made by the Office. Those claims are drawn to carbon cages containing 60 or 70 carbons. Applicant further points out that proposed claims 202, 209-211, 215, 221, 222 and 239-245 are limited to fullerenes having a polyhedral, spherical or icosahedral structure. Applicant asserts that claims 202-245 would clearly simplify the issues for appeal.

The examiner on September 24, 2009 had concerns with applicant’s proposed language of “A substantially pure fullerene compound comprising a polyhedral carbon cage” that was not supported by the original disclosure because the present day meaning of fullerene encompasses carbon nanotubes and the term fullerene was not used in the original disclosure. Applicant’s supplemental amendment still cites the term “fullerene”. The examiner’s position is that claims 202-245 are not responsive to any interview and do not adopt any suggestions made by the examiner that would place the application into condition for allowance.

While some claims appear to adopt the examiner’s suggestions, others do not. For example, claims 202, 205-215, 218-223, 226-235, and 238-245 do not adopt any examiner suggestions. Applicant’s petition in fact does not actually assert that these claims adopt the examiner’s suggestions. Rather, the petition asserts that these claims “address concerns” raised by the

examiner. Attempting to address a concern is not adopting a suggestion, as a suggestion has been agreed to in advance, whereas an attempt to address a concern has not. Thus the reply is not limited to claims that meet the conditions of 37 CFR 1.111(a)(2)(B).

Nor can these claims be said to simplify the issues on appeal. Applicant's petition does not point to any particular issue present in the non-final rejection of September 12, 2008 which the addition of these claims would remove from consideration. To the contrary, they appear to raise a variety of new issues, such as the enablement of claims reciting an atom enclosed within the cage (e.g. claim 206) when the specification does not appear to describe how this is accomplished, the scope of enablement for claims covering any and all molded products including the claimed fullerene (e.g. claim 211) when no such products are actually described in the specification and claim interpretation issues and the patentability of the claims over the prior art (e.g. "effectively spherical" as in claims 241 and 245). Given the above, the September 25, 2009 amendment appears to complicate, rather than simplify, the potential issues for appeal. Thus the reply is not limited to claims that meet the conditions of 37 CFR 1.111(a)(2)(F).

The remaining provisions of 37 CFR 1.111(a)(2) do not apply, nor were they asserted. Since entry of supplemental replies is not a matter of right, and none of permissive conditions of 37 CFR 1.111(a)(2) apply, the supplemental reply filed on September 25, 2009 was properly denied entry.

With respect to applicant's arguments concerning their right to respond under 37 CFR 1.112, the mere discussion of issues or hypothetical situations during an interview does not constitute an action and does not afford applicants the right to supplemental amendments. Interview practice is addressed in 37 CFR 1.133, not 37 CFR 1.112.

Applicants argue that equity warrants entry of the Supplemental Amendment however supplemental replies are governed by 37 CFR 1.111(a)(2). A review of the record indicates that entry of the Supplement Amendment would not be allowed under 37 CFR 1.111(a)(2).

In the Final Rejection of June 23, 2010, newly presented claims 110, 111, 120-161 and 164-179 were rejected under 35 USC 112, first paragraph. Applicants assert that the previous Non-Final Office Action dated October 27, 2008 did not include any rejection under 35 USC 112, first paragraph and that the 35 USC 112 first paragraph issues should have been first raised in the Non-Final Office Action. The scope of the newly presented claims was different from the claims that were originally presented. Applicant's amendment necessitated the new ground of rejection presented in this Office Action. The finality of the Office Action is proper.

Applicants assert that the newly raised 112, first paragraph rejection is a clear error and sets forth arguments to support their position. A rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences and is not a petitionable issue.

## DECISION

The petition is **DENIED**.

\_\_\_\_\_/Sharon.A. Gibson/\_\_\_\_\_  
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